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26 JAN 2006

Gregory J. Maier  
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In re Application of  
SCHMIDT, et al.  
U.S. Application No.: 10/516,297  
PCT No.: PCT/EP03/06130  
Int. Filing Date: 11 June 2003  
Priority Date: 13 June 2002  
Attorney Docket No.: 262434US2PCT  
For: METHOD AND INSTRUMENT FOR SURGICAL:  
NAVIGATION

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a)" filed 19 December 2005 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 11 June 2003, applicant filed international application PCT/EP03/06130, which claimed a priority date of 13 June 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 13 December 2004.

On 09 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee, an English translation of the international application, a First Preliminary Amendment and an Information Disclosure Statement.

On 18 May 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicants of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 19 December 2005, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a five-month extension of time and payment of the appropriate five-month extension fee. With the filing of the extension of time petition and payment of the extension fee, applicant's response is considered timely filed.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied all four items.

Regarding item (1), applicant has provided payment of \$130.00. Applicant is advised that the petition fee for a petition under 37 CFR 1.47 is \$200.00 pursuant to 37 CFR 1.17(g). As authorized, \$70.00 will be charged to deposit account number 15-0030.

As to item (2), applicant has provided sufficient evidence to show that Mr. Eckert refuses or because of his duties at the European Patent Office is unable to execute the declaration thus satisfying this item.

Regarding item (3), applicant has provided the last known address of the non-signing inventor.

As to item (4), applicant has filed a compliant declaration of the inventors executed by the remaining inventors on their own behalf and on behalf of the non-signing inventor.

Accordingly, it is proper to grant applicant's petition at this time.

### CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 11 June 2003 under 35 U.S.C. 363, and will be given a date of **19 December 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

Application No.: 10/516,297

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This application is being returned to the DO/EO/US for processing in accordance with this decision. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).

A handwritten signature in black ink, appearing to read 'Derek A. Putonen'.

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Mr. Lars Eckert  
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For: METHOD AND INSTRUMENT FOR SURGICAL  
NAVIGATION

Dear Mr. Eckert:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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